Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

PUBLICATIONS INTERNATIONAL, LTD.,

Petitioner,

v.

LANDOLL, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Did the Court of Appeals find the trade dress of Petitioner's cookbooks and children's books to be insufficiently distinctive for trade dress protection without applying any standard of law?

2. Does the decision of the Court of Appeals conflict with decisions of the other Circuits as to the standards for distinctiveness of trade dress and the burden of proof on the issue of functionality of trade dress?

3. Did the Court of Appeals improperly apply the concept of aesthetic functionality to utilitarian cookbooks and children's books?

PARTIES TO THE PROCEEDING

Publications International, Ltd., brought this proceeding against Landoll, Inc. Publications International, Ltd., has no parent company, nor is it a non-wholly owned subsidiary of any other company or corporation.

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OPINIONS BELOW

The opinion of the Court of Appeals is reported at 164 F.3d 337, and is reproduced at page 1 of the Appendix to this Petition. The opinion of the district court is reported at 45 U.S.P.Q. 2d 1277, 1997 WL 769349 and is reproduced commencing at page 13 of the Appendix to this Petition.

STATEMENT OF JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered on December 16, 1998. No petition for rehearing was filed. This Petition for Writ of Certiorari is filed within ninety days of the entry of the Court of Appeals' judgment. The jurisdiction of this court rests on 28 U.S.C. §1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Amend. VII to the United States Constitution

In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

The Lanham Act, 15 U.S.C. §1125. False designation of origin, false descriptions, and dilution forbidden

(a) Civil Action

(1) Any person who, or in connection with any goods or services, or any container for goods, uses in com-

merce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

STATEMENT OF THE CASE

Petitioner, Publications International, Ltd., respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit affirming the decision of the United States District Court for the Northern District of Illinois, granting summary judgment for defendant.

This cause was brought by plaintiff pursuant to the Lanham Act, 15 U.S.C. §1125, alleging defendant had infringed the trade dress of plaintiff's cookbooks and children's storybooks. The district court granted defendant's motion for summary judgment and entered judgment for defendant, which judgment was affirmed by the Court of Appeals.

Petitioner (hereinafter referred to as "PIL") has been in the business of publishing books for nearly twenty-five years. Cookbooks have been one of its specialties. In 1993, it began producing large, heavy cookbooks containing 684 pages, a page size (trim size) of 8½" x 11", with padded, high-gloss covers and page edges gilded in gold. No one had ever published cookbooks in that format before. These books instantly became hugely successful. PIL selected that trade dress because it was distinctive, unique and arbitrary. It was chosen to distinguish and identify the books as coming from PIL. When these cookbooks were first produced, one of Plaintiff's officers observed that PIL had succeeded in producing the "Mother of All Cookbooks." Shortened to its acronym "M.O.A.C.," they have been uniformly described by that catch-phrase internally at PIL and by its customers, many of whom order them by the use of that term. Similarly, the children's line of books is uniformly referred to as "Treasuries" by both PIL and its customers.

Between their introduction in 1993, and mid-February, 1997, PIL had sold nearly three million copies of the cookbooks containing this trade dress for gross sales of over twenty-three million dollars. Wishing to build on the huge success of these cookbooks, in 1994 PIL adapted this trade dress for its line of children's storybooks, reducing the page size slightly, and reducing the number of pages in the book to 384 pages. In all other respects the trade dress was the same. Those books were hugely successful as well. Between their introduction in late 1994 and early 1997, PIL sold over two million copies of these children's treasuries with gross sales of over thirteen million dollars.

Early in 1995, Respondent Landoll began publishing cookbooks and children's books containing the identical trade dress of PIL's books. They were the same page size, same page count, having padded, high-gloss covers, with the page edges gilded in gold. Landoll used the same printer for its books as PIL was using—a printer with whom Landoll had never before done business. Not surprisingly, Landoll's books had the same look and feel as PIL's books. PIL then brought this action under the Lanham Act seeking injunctive relief and damages.

Landoll filed a motion for summary judgment, based upon the single assertion that since PIL's trade dress was not inherently distinctive, Landoll had the freedom to slavishly copy that format. Acknowledging the confusion as to the appropriate test to be applied in deciding the issue of trade dress in the context of product configuration, the district court concluded PIL's alleged trade dress was not sufficiently "unique, unusual or unexpected" in the book market to "automatically be perceived . . . as an indicator of origin" finding it to be a mere refinement of existing ornamentation. Although stating that it was not ruling upon the issue of functionality, the district court nevertheless found that the elements of Plaintiff's claimed trade dress make the product more desirable to consumers, a "deluxe" product, thereby rendering them functional and not entitled to trade dress protection. (Appendix, 34) The district court therefore entered summary judgment for Landoll.

The Court of Appeals affirmed. Acknowledging that the courts have struggled to articulate a standard to determine when a trade dress is sufficiently distinctive

to be entitled to the protection of the Lanham Act, the court simply concluded that "efforts to define intuitive concepts such as 'distinctiveness' are often both futile and unnecessary." (Appendix, 2) In an opinion that can only be described as murky, the Court of Appeals found each of the features of PIL's trade dress to be "functional,"[1] but acknowledged that a combination of functional features may turn out to be distinctive enough for trade dress protection. (Appendix, 9) Without giving any explanation or applying any discernible test, the court concluded that neither PIL's cookbooks nor children's books were sufficiently distinctive to be entitled to trade dress protection[2] because they were just another "*type* of cookbook." (Appendix, 10, emphasis in original)

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[1] With virtually no evidentiary support in the record, the Court of Appeals held the various elements of PIL's cookbooks to be functional because a) large pages lay flat in the kitchen while the cook is using the book; b) large print is easy to read; c) recipe is on one page and the picture of the dish is on the facing page, making it easier to see what the food is supposed to look like when completed; d) shiny oilcloth covers makes the book easier to clean; and e) gilding on the pages masks "bleeding" of the photographs onto the edge of the pages. The court even went so far as to invoke aesthetic functionality in regard to the use of gold gilding on the book's pages. (Appendix, 8)

[2] Again, without any support in the record, the court opined that the children's books were "functional" because the gilding prevented "bleeding" of the pictures onto the edges of the pages, they were easy to clean off children's dirty fingerprints, and "children love gold." (Appendix, 11)

REASONS FOR GRANTING THE WRIT

I.

THERE IS NO ASCERTAINABLE UNIFORM STANDARD OF DISTINCTIVENESS TO DETERMINE WHETHER ANY TRADE DRESS IS ENTITLED TO PROTECTION

Both the district court and the Court of Appeals acknowledged difficulty in conceptualizing what makes a trade dress sufficiently distinctive to entitle it to protection under the Lanham Act. 15 U.S.C. §1125(a). In the end, the Court of Appeals gave up trying to articulate the reason for its decision, merely concluding PIL's books were "just another type" of book, as dictionaries, encyclopedias, atlases, law books and comic books are "types" of books. (Appendix, 10) Such cavalier treatment of serious business issues is simply unacceptable.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992), this Court held that a product with an inherently distinctive configuration is capable of identifying that product as coming from a specific source and is therefore entitled to trademark protection, without a showing of secondary meaning. Since then, the courts have made a hopeless jumble of what is sufficiently distinctive to entitle a product configuration to trade dress protection. The decision by the Court of Appeals in this case is the culmination of that confusion. Rather than articulate a basis for its conclusion, the court has simply relied upon an "intuitive" impression of the product in reaching its result. Unfortunately, everyone's intuition is not the same. This approach provides no guidance whatsoever to anyone wishing to assert trade dress rights or to those wishing to know whether they may copy the

features of another's product or not. Under this approach, the answer can be given only after extended and expensive litigation. Moreover, the result of such litigation under this scenario is variable in each instance and impossible to predict.

The parties both sell their goods nationally. This suit involves a federal statute, which should be applied to all throughout the country consistently. Neither the rights of these parties, nor the rights of any other national manufacturers, should vary depending upon which court in which geographical area of the country happens to hear the case. However, as we discuss below, currently those rights will be greatly different depending upon which court happens to consider them.

The courts of appeals have not been able to agree on a definition of distinctiveness. The Seventh Circuit has not adopted a definition for inherent distinctiveness in product configuration trade dress cases. *Sassafras Enterprises, Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 5 (N.D. Ill. 1996). Although it had the perfect opportunity to adopt a definition in this case, it did not do so, but instead, opted to decide the case based upon the court's visceral impression of the product, instead of allowing a jury to decide the issue under proper directions after a trial at which each side was able to fully develop its evidence. It used a novel theory of functionality as a substitute for distinctiveness. Rather than decide whether the books were sufficiently distinctive to be capable of identifying their source, the court castigated PIL for not having used a "traditional" trademark to distinguish its books from those who might copy its product. (Appendix, 10) Not only is this contrary to the clear terms of the Lanham Act, but it eviscerates this

Court's holding that a product with an inherently distinctive configuration is entitled to protection with no showing of secondary meaning. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992).

PIL's books are unquestionably unique. The combination of elements PIL uses for its books is arbitrary and under any standard is inherently distinctive. That they may incorporate several common design elements found in other books but combine them in a novel manner does not render them non-protectable. *Taco Cabana, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 (5th Cir. 1991); *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063, 1069 (7th Cir. 1992). While purporting to recognize this precept, the Court of Appeals then ignored it in reaching the conclusion that PIL's products were just another "type" of book without any factual basis upon which to rest that statement. Thus, the decision here is in direct conflict with other courts which have reached the contrary conclusion. "One could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of commonly used letters of the alphabet." *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 584 (2nd Cir. 1993).

As a result of the utter confusion between the approaches of the various courts of appeals as to the definition of distinctiveness, no manufacturer is able to determine whether its product has a trade dress which is entitled to protection. Whether it will be entitled to protect a product configuration will depend upon the happenstance of which court decides the issue. Compet-

itors have no reasonable way of determining whether they are infringing the rights of another. Whether they are guilty of infringement, and potentially subject to millions of dollars in damages, depends upon where suit is filed against them. Such important rights ought not depend upon who wins the race to the courthouse.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, supra, this Court endorsed the classic categories of distinctiveness set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976): (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or (5) fanciful. 505 U.S. at 768. Since then, several courts have departed from this test when deciding whether product configuration is entitled to trade dress protection. The evolutionary paths are vastly inconsistent. The Fifth Circuit has adopted the *Abercrombie* test. *Pebble Beach Co. v. Tour 18 Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998); *Sunbeam Products, Inc. v. The West Bend Co.*, 123 F.3d 246, 252 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998). The Eleventh Circuit seems to follow *Abercrombie* also. *University of Florida v. KPB, Inc.*, 89 F.3d 773, 776 (11th Cir. 1996). While the Second Circuit uses the *Abercrombie* test for a product's packaging in trade dress cases it, for a time, appeared to use an entirely different test in discussing product design and configuration trade dress. In order to qualify for trade dress protection, the manufacturer of a product was required to show the design was primarily intended as source identification, focusing on the intent of the manufacturer, rather than the reaction of the consumer. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2nd Cir. 1995).

The Second Circuit's two latest decisions on the issue seem to have adopted a different approach, however. In

Samara Brothers, Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120 (2nd Cir. 1998), the court upheld a jury award of over a million dollars, based upon a finding that a line of clothing was sufficiently distinctive to enjoy trade dress protection, because the evidence at the trial depicted a "distinctive combination of ingredients" in the trade dress, warranting Lanham Act protection, as the design was "likely to be understood as an indicator of the product's source." Similarly, In *Nora Beverages, Inc. v. Perrier Group of America, Inc.*, 164 F.3d 736 (2nd Cir. 1998), decided at about the same time, the Second Circuit reversed a summary judgment order based upon a finding of non-distinctiveness of a bottle for spring water, and remanded the case for a jury trial because the plaintiff's evidence that its bottle design was unique at the time of its introduction into the market raised a genuine factual dispute which required a jury trial. This approach is correct. It is consonant with the prior teaching of this Court, and the majority of the decisions of the courts of appeals.

The decision of the court below in this case is directly contrary to the holdings of the Second Circuit in these two cases. PIL's cookbooks and children's books are undoubtedly as distinctive as the clothes and bottles considered by the Second Circuit in *Samara Brothers* and *Nora Beverages*. Had this case been considered by the Second Circuit, rather than the Seventh, Landoll's summary judgment motion would have been denied and the case set for a trial before a jury.[3]

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[3] The Seventh Circuit's decision effectively abrogated PIL's Seventh Amendment right to a trial by jury. Trademark cases

(continued...)

The First Circuit has stated that inherent distinctiveness of a product design should be determined by reference to whether the design is a "common" basic shape or design, whether it was unique or unusual in a particular field, whether a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods or whether it is capable of creating a commercial impression distinct from accompanying words. *Wiley v. American Greeting Cards*

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[3] (...continued)

present legal claims triable by a jury as a matter of right. *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 82 S.Ct. 894, 8 L.Ed. 2d 44 (1962). It is well settled that distinctiveness is a question of fact to be decided by a jury. *Boston Beer Co. v. Slesar Bros. Brewing Co. Inc.*, 9 F.3d 175, 180 (1st Cir. 1993); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1039-40 (2nd Cir. 1992); *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263 (Fed. Cir. 1995). It is equally well settled that functionality is also question of fact to be decided by a jury. *Inwood Laboratories, Inc. v. Ives Laboratories*, 456 U.S. 844, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982); *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, 111 F.3d 993, 1002 (2nd Cir. 1997); *Hupp v. Siroflex*, 122 F.3d 1456 (Fed. Cir. 1997). The Seventh Circuit's decision is tantamount to a rejection of this proposition, turning the issues of distinctiveness and functionality into questions of law. This is an invasion of the province of the jury.

The right to a jury trial has constitutional implications, as this Court recently recognized this last term in *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 118 S.Ct. 1279, 140 L.Ed.3d 438 (1998), where it was reiterated that the Seventh Amendment guarantee of a jury trial applies not only to common-law causes of action, but also to "actions brought to enforce statutory rights that are analogous to common-law causes of action ordinarily decided in English law courts in the late 18th century, as opposed to those customarily heard by courts of equity or admiralty." PIL has been deprived of its constitutional right to have those issues tried by a jury.

Corp., 762 F.2d 139 (1st Cir. 1985); *I.P. Lund Trading Aps. v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). The Eighth Circuit seems to have used this approach as well in *Children's Factory, Inc. v. Benee's Toys, Inc.*, 160 F.3d 489, 494 (8th Cir. 1998), although it had previously used the *Abercrombie* test. *Insty*Bit, Inc. v. Poly-Tech Industries, Inc.*, 95 F.3d 663, 673 (8th Cir. 1996).

The Third Circuit has developed a highly restrictive test requiring that the design owner prove that the product configuration is "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product. *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1449 (3rd Cir. 1994).

Like the Seventh Circuit in this case, the Ninth and Tenth Circuits seem to have abandoned any attempt to define distinctiveness, opting instead for language which merely identifies the result. Thus, the Ninth Circuit has stated, "a mark or dress is distinctive when it identifies the particular source of the product or distinguishes it from other products." *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993). Similarly, the Tenth Circuit states that a product's features are inherently distinctive "because their intrinsic nature is such as to almost automatically tell a customer that they refer to a brand." *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1502 (10th Cir. 1995), cert. denied, 516 U.S. 1067, 116 S.Ct. 753, 133 L.Ed.2d 700 (1996).

How is any business to know what its rights are in this area? This is not a mere theoretical quibble. Mil-

lions of dollars are at stake in many of these cases. See *Samarra Brothers, Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120 (2nd Cir. 1998). This is an issue which cries out for this Court's guidance.

II.

THERE IS HOPELESS CONFUSION AMONG THE CIRCUITS REGARDING FUNCTIONALITY

The conflict regarding functionality is just as pronounced. As the Court of Appeals in this case acknowledged, the circuits do not agree on which party has the burden of proving functionality. The court here brushed that difference of opinion aside as being of little relevance, since both sides have access to the same information, and it matters little who introduces the evidence which (presumably) will be introduced in any event. (Appendix, 5) This is simply untrue, particularly when dealing with motions for summary judgment, where which party bears the burden of proof is of the utmost importance.[4]

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[4] The Fourth, Second, Seventh and Tenth Circuits place the burden of proving functionality on the defendant. *Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234 (4th Cir. 1997); *LeSportsac, Inc. v. Kmart Corp.*, 754 F.2d 71, 75-76 (2nd Cir. 1985); *Computer Care v. Service System Enterprises, Inc.*, 982 F.2d 1063, 1068 (7th Cir. 1992); *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995), cert. denied, 516 U.S. 1067, 116 S.Ct. 753, 133 L.Ed.2d 700 (1996).

The First, Third, Fifth, Sixth, Eighth, Ninth and Eleventh Circuits place the burden on the plaintiff to show that its product's features are nonfunctional. *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193 (1st Cir. 1980); *CIBA-GEIGY Corp. v. Bolar Pharmaceutical Co.*, 747 F.2d 844 (3rd

(continued...)

Of even more importance, however, is the proper definition of functionality. The courts have been unable to agree in this area either. All courts agree, and it can hardly be disputed, that if a feature is functional, it is likely that all similar articles will have a similar functional feature, and one seller's feature is not likely to evoke any response in buyers that it is a unique or distinctive symbol of origin. *I.P. Lund Trading Aps. v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). Since the policy of the Lanham Act is to promote competition, protection will not be accorded a trade dress when to do so prevents another from competing effectively. *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, 111 F.3d 993, 1002 (2nd Cir. 1997).

Functionality means that the entire trade dress, taken as a whole, is functional, not just certain component parts. It means that the trade dress is one that would be found in most or all brands of the product, even if no producer had any desire to have his brand mistaken for that of another. *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063, 1068 (7th Cir. 1992).

In this case, there is no evidence whatsoever that the number of designs available for cookbooks and chil-

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[4] (...continued)

Cir. 1984); *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998); *Kwik-Site Corp. v. Clear View Mfg. Co.*, 758 F.2d 167 (6th Cir. 1985); *Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244 (8th Cir. 1990); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987); *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986).

dren's books is limited, or that extension of trade dress protection to PIL's book designs would restrict Landoll's ability to produce alternative competitive designs, nor did the district court so find. In fact, the evidence of record shows the design possibilities for such books are virtually infinite. Since no other cookbook or children's book has ever used the combination of features found in PIL's books until Landoll began copying them, it is impossible to conclude that the design of those books is functional. It is contrary to the purposes of the Lanham Act to limit protection to those designs of articles only where the design was useless and wholly unrelated to the function of the article. The court below lost track of the fundamental question in all trade dress cases: is the design sought to be protected essential to effective competition? Can others compete with PIL in the cookbook and children's book field without copying the specific design of its books or not? If they can, PIL's trade dress is not functional. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982).

The Court of Appeals found Plaintiff's trade dress to be functional because the padded covers and gilded covers made the books more desirable and "deluxe" looking, thereby becoming aesthetically functional. (Appendix, 8) This is absolutely not the test of functionality. The Court ignored its own prior holdings in reaching this conclusion. In *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176 (7th Cir. 1989) functionality was described as a design or feature which is superior in terms of manufacture, accommodation or utilitarian function or performance. A feature is functional only "if it is one that is costly to design around or do without rather than one that is costly to have." It

has long been held that even though individual elements may be functional, when grouped together the aggregate may be protected trade dress. *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1272 (10th Cir. 1988), cert. denied, 488 U.S. 908, 109 S.Ct. 260, 102 L.Ed.2d 248 (1988). Upon what possible basis can it be held that a distinctive trade dress loses all protection because it is "aesthetically pleasing?" Injecting such a nebulous concept into an already confused area insures a reign of chaos. Where millions of dollars are at stake, such an unfocused, result-oriented approach simply cannot be tolerated.

The attractiveness of a product's design does not make it functional. The question is: Can others effectively compete without the same design? In determining whether a product feature is functional, a court may consider a number of factors including the availability of alternative designs and whether a particular design results from a comparatively simple or cheap method of manufacture. If there are commercially feasible alternative configurations which actually exist, then it is not functional. *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1513 (9th Cir. 1992). The court below did not acknowledge, or seem to realize the import of these decisions.

Several decisions have held the fact that a feature or combination of features makes the product aesthetically appealing does not transform a distinctive trade dress into a functional design. While aesthetic appeal may in some circumstances become functional, such as on apparel or jewelry, the real question is whether alternative appealing designs or presentations of the product

can be developed. *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987). In *Vuitton et Fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 773 (9th Cir. 1981) the court explicitly rejected an interpretation that would define any feature of a product that contributes to its consumer appeal and marketability as a functional element as a matter of law. The question is whether protection of the trade dress will hinder competition. A product feature is functional and not entitled to trade dress protection only if "exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage." *Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002 (9th Cir. 1998). There is not one iota of evidence in this case that competition will be hindered if others cannot slavishly copy PIL's configuration for their cookbooks and children's books.

The resurrection of the aesthetic functionality concept as applied to PIL's books by the court below conflicts with the holdings of a majority of the circuits, which have mandated that to be functional, a product feature must have a significant relation to the utilitarian function of the product. *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1142 (3rd Cir. 1986). It would be directly contrary to the purposes of the Lanham Act to deny one protection for its trade dress because it was more pleasing or attractive than its competitors'. As this Court has recognized, something is functional if "it is essential to the use of or purpose of the article or it affects the cost or quality of the article." *Inwood Laboratories, Inc. v. Ives Laboratories,* 456 U.S. 844, 102 S.Ct. 2182, 72 L.Ed.2d 606 (1982). The ruling below in this case conflicts with the long-held

view that the arbitrary combination of functional features is not functional. The ultimate inquiry, of which the court below lost track, is whether characterizing a feature or configuration as protected will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods. *Sunbeam Products Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), cert. denied, 118 S.Ct. 1795, 140 L.Ed.2d 936 (1998); *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084 (6th Cir. 1983). A decision which injects such confusion into the law of trade dress must not be allowed to stand.

CONCLUSION

This case implicates issues of the utmost public and commercial importance, involving untold millions of dollars. Manufacturers are entitled to know what rights they possess in designing trade dress for their products. Competitors are entitled to uniform, reasonable rules as to what features of their products may be protected from use by others, and what are in the public domain. In cases such as this which turn on public perception of products in a competitive environment, whether the seller of a product has a right to protect the configuration of that product from predatory copying should be decided by a jury, not judges. The state of the law in this area is so unsettled that vast confusion currently reigns. The time is ripe for this Court to consider these important issues to provide guidance to the courts and the public.

Wherefore, petitioner prays that this Court's Writ of Certiorari issue and that the judgment below be reversed with directions that the district court's grant of summary judgment be vacated and this cause remanded for trial by a jury.

Respectfully submitted,

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